

REMARKS

In response to the Written Opinion in the above-named Application, mailed on 01 November 2004, Applicant provides herewith seventeen (17) sheets of Replacement Claims. Claims 1, 3, 32, and 48 are replaced by amended Claims bearing the same numbers; Claims 2, 4-31, 33-47, and 49-101 are unchanged.

1. Claims 1-4, 8-12, 14-34, 38-42, 44-72, 79-83, and 86-103 are considered by the Examiner to lack novelty under PCT Article 33(2) as being anticipated by Compensate.com. Applicants respectfully disagree and submit that Compensate.com fails to teach, suggest, or render obvious the present invention as claimed.

Screen shots of Compensate.com dated 02/04/1998, 05/05/2001 and 02/20/1999 are provided as reference to describe the aspects of Compensate.com. We believe that the screen shots by themselves fail to teach or suggest the present invention, as described and/or claimed by PayScale.

Specifically, the Examiner equates the way surveys are performed according to Compensate.com and those performed in accordance with the disclosed invention. However, it is clear from the description at Compensate.com and further in the '832 patent that the basic surveying is different. Compensate.com automates standard thinking of surveys, i.e., a list of predetermined questions and answers that is provided to a person taking the survey at a predetermined sequence. All the

documentation the Examiner is quoting shows that a well-structured survey takes place of which the user has no impact on. A series of questions will be asked and once determined there can be no change from the affiliation, or affinity group, to which such a user is placed with. The Examiner even notes that "*An affinity group comprises at least a job family...*" and he is correct for the limited Compensate.com survey tool. However, such a requirement is never placed on a survey performed in accordance with the present invention, and in fact, a job family is not even required.

In accordance with the invention, the list of survey questions presented to a user is dynamically built based on responses received from the user. This allows for a significantly finer association with one or more affinity groups. According to Compensate.com that is not possible and a user will always be associated with a single group. This is further acknowledged by the Examiner who states that "*The answers allow a user to be grouped with a matching affinity group.*" Nowhere is it shown that a user could be associated with multiple affinity groups, including those not previously existing in the system, allowing other more specific questions to be asked at each time other affinity group associations are established, an invention that significantly enhances the ability of an individual user, or employer, to match like profiles in more detail. It should be further notable that the flexibility of the present invention allows for the use of the system beyond salary surveys, and it is not limited to such, as opposed to Compensate.com where salary and job definitions are built-in to the very fabric of operation. Hence, the Compensate.com system is limited to a rigid set of predetermined questions and answers leading to a single affinity group. Therefore, even Market pay surveys referred to by the Examiner as being taught by

Compensate.com are limited to that set of questions and answers, and are unable to address affinity groups not hard coded into the survey itself.

Thus, Applicants respectfully submit that Claims 1-4, 8-12, 14-34, 38-42, 44-72, 79-83, and 86-103 are distinguishable over Compensate.com and should be considered as being novel.

2. Claims 5-7, 13, 35-37, 43, 73-78, and 84-85 are considered by the Examiner to lack an inventive step under PCT Article 33(3) as being obvious over Compensate.com. Applicants respectfully disagree and submit that Compensate.com fails to teach, suggest, or render obvious the present invention as claimed.

The Examiner provides the same screen shots as above as reference to describe the aspects of Compensate.com.

Claims 5-7 and 35-47. The Examiner states that Compensate.com discloses on-line surveys and a user entering answers to the survey. We respectfully disagree. Compensate.com fails to disclose the presentation of questions in the manner claimed in the present invention, i.e., the case where a question is presented based on the specific answer received for a previous question, thereby allowing for tailoring of a survey to the specific user taking the survey, and more specifically for the purpose of associating that person to one or more affinity groups. While open text entering is know-in-the-art for form filling, the use proposed is novel and new. Specifically, a user is allowed to add an answer to a list of answers if the answers that were made available were insufficient. From that moment onwards, these

answers may be used as part of the answers presented by the survey. Prior art may allow answering certain questions with an open text where the idea is to allow a user to provide additional information in free form. However, such surveys do not allow the use of such free form text in the context of answers that become part of the answers used for questions presented to a user.

Claims 13 and 43. The Examiner agrees that Compensate.com fails to teach the modification of answers provided by a user based on the qualifications disclosed in these claims. However, the Examiner elects to state that it would have been obvious to do such a thing in order to increase the accuracy of the results. We respectfully disagree and believe that this assertion by the Examiner is a hindsight learning made as a result of the disclosure of the invention.. The modification of an answer to a question asked in a survey is not a trivial undertaking. It is further more complex considering the plurality of affinity groups that a user may be associated to in accordance with the invention (and not possible according to Compensate.com). In Compensate.com, a CEO of a large corporation may indicate a salary, which would be clearly wrong and pass the survey with no filter whatsoever, thereby affecting the results and accuracy of the entire system. Moreover, in the context of the survey performed in the manner disclosed in the invention, this is an important step to ensure clean data as part of the total solution.

Claims 73-78 and 84-85. The Examiner errs in asserting that "*Compensate.com discloses selecting of a first profile currently entered and not matched with an affinity group, comparing the user profile with other user profiles of the system, finding an appropriate affinity group for the first user, and preparing a report for the first user...*".

There is no comparison performed at any step disclosed by Compensate.com. It would not be necessary as the affinity group according to Compensate.com is determined with the specific questions as they are presented to the user, i.e., if the affinity group is "Accounting" the user will not be affiliated with any other affinity group. Compensate.com operates solely within the realm of job families and specific pre-defined levels of responsibility within each job family. In accordance with the present invention as claimed, a match process occurs for each of the answers that a user has provided, and as noted previously, the survey itself is a unique survey to the specific user, as its questions were generated in response to the answers given rather than the rigid set of questions and answers that typify solutions such as shown by Compensate.com. In accordance with the invention, in order to match an unmatched user to an affinity group a plurality of match fields are tested, between the unmatched user and those users which have been previously determined as being part of the affinity group. It is possible, in accordance with the invention, that persons of different job families but similar (not necessarily identical) responsibilities, skills, and even non-job attributes such as location or type of company, be part of an affinity group. Because in accordance with the invention a user does not have to belong to a single affinity group, such matching technique is essential to a successful implementation of the invention. By contrast, Compensate.com does not perform even a single match. If the user responds that he belongs to a certain job family, that will be his single affiliation, and nothing else will be checked, limiting significantly the possibilities that could otherwise be provided to such user.

The Examiner claims that it would have been obvious to a person skilled-in-the-art to group a smaller group into sub-affinity groups and then match those with larger

affinity groups of the system. We believe that this assertion by the Examiner is a hindsight learning made as a result of the disclosure of the invention. Such a feature would be beneficial enough to be included as part of Compensate.com solution had they known of a way of doing so using the Compensate.com methodology. With the limitations of the system used by Compensate.com it is impossible to create sub-affinity groups by the system. Rather, the sub-affinity group, as the Examiner prefers to call them, are a result of a predetermined action of a one-time developer of the system, and it is not generated automatically by the system that is capable of matching a plurality of match fields, as shown by the present invention.

Thus, Applicants submit that Claims 5-7, 13, 35-37, 43, 73-78, and 84-85 are distinguishable over Compensate.com and should be considered as having an inventive step.

CONCLUSION

Based on the foregoing, Applicant considers that Claims 1-4, 8-12, 14-34, 38-42, 44-72, 79-83, and 86-103 should be considered novel and that Claims 5-7, 13, 35-37, 43, 73-78, and 84-85 should be considered as having an inventive step.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ivy Lee May', with a long horizontal flourish extending to the right.

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